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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/826,236	04/16/2004	Akira Hashimoto	36856.1244	9646

35510 7590 03/16/2005

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EXAMINER

YAN, REN LUO

ART UNIT	PAPER NUMBER
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2854

DATE MAILED: 03/16/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/826,236

Applicant(s)

HASHIMOTO ET AL.

Examiner

Ren L. Yan

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 April 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 April 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 4/16, 12/17/04.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

3. Claims 1-3 and 5-17 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1-13 of copending Application No. 10/788,008. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented. The scope of the claimed inventions between the present application and copending application No. 10/788,008 is identical.

Claims 15-17 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Method claims 15-17 contain recitation of a use, without setting forth any steps involved in the process, resulting in an improper definition of a process, i.e., resulting in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd. v. 8renner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

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4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 15-17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 15 provides for the use of a photogravure press, but, since the claim does not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1, 2, 4, 6, 8-10, and 12-14 are rejected under 35 U.S.C. 102(b) as being anticipated by Shimizu (US 5,033,377). Shimizu teaches the structure of a photogravure press as claimed comprising a gravure roll 7 having image areas on a circumferential surface thereof and having print paste applied thereon so as to form the paste films, an impression cylinder 12 facing the gravure roll having the substrate sheet sandwiched therebetween, in each image area a plurality of printing direction walls (Fig. 6) extending in the printing direction and a plurality of substantially perpendicular walls (Fig. 6) extending substantially perpendicularly to the printing

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direction walls are disposed, a plurality of cells are defined by the printing direction walls and the substantially perpendicular walls, in order for the adjacent cells to communicate with each other, each of the substantially perpendicular walls has a plurality of substantially perpendicular cuts 3(Fig. 6) formed therein so that the substantially perpendicular wall extends intermittently having the substantially perpendicular cuts interposed therein, each of the printing direction walls extends continuously in the image area, two kinds of the substantially perpendicular walls are alternately disposed in the printing direction such that one lies in contact with any one of the printing direction walls (Fig. 6) and the other lies in contact with the above printing direction wall having the corresponding substantially perpendicular cut interposed therebetween and each cell has the substantially perpendicular cuts at its two corners diagonally opposed to each other (Fig. 6), the outermost ones of the printing direction walls have no substantially perpendicular cuts formed outside thereof, each of the printing direction walls has a plurality of printing direction cuts formed therein so that the substantially perpendicular wall extends intermittently having the printing direction cuts interposed therein (Fig. 5), the printing direction walls are disposed so as to intersect with the substantially perpendicular cuts (Fig. 5), the substantially perpendicular walls are disposed so as to intersect with the printing direction cuts and either one of the substantially perpendicular cuts and the printing direction cuts being disposed at each corner of each of the cells (Fig. 5), the perpendicular cuts which are adjacent to each other in the printing direction take different positions from each other in the perpendicular direction with respect to the printing direction (Fig. 6), a portion of the cells lying on the printing start side and another portion lying on the printing end side of the image area are formed so as to have the same open area as each other, all of the plurality of cells are substantially identical in

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depth, and the length of the image area extending in the circumferential direction of the gravure roll being smaller than a nip width provided by the gravure roll and the impression cylinder (Fig. 1).

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Shimizu. The patent to Shimizu teaches all that is claimed except that it does not teach the gap of each of the substantially perpendicular cuts being greater than the width of each of the printing direction walls and the substantially perpendicular walls. However, Shimizu does teach that the gap of the perpendicular cuts is approximately the same size as the width of the printing direction walls and the perpendicular walls (col. 6, lines 12-14). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Shimizu to have the width of the gap be larger than the width of the walls, since the teaching of Shimizu to make the width of the gap and the walls approximately the same allows for deviation such that the width of the gap could be larger or smaller than the walls.

Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Shimizu in view of Samworth (US 6,731,405). Shimizu teaches the claimed invention except for a portion of the plurality of cells lying in the peripheral portion of the image area having smaller

open areas than those of another portion of the plurality of cells lying in the central portion of the image area. Samworth teaches a portion of a plurality of cells lying in the peripheral portion of the image area having smaller open areas than those of another portion of a plurality of cells lying in the central portion of the image area (Fig. 8). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Shimizu to have the cells in the peripheral portion be smaller than the cells in the central portion, since varying the size of the cells allows for creating varying designs.

Claims 7 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shimizu in view of Levy (US 6,701,839). Shimizu teaches the claimed invention except for at least one start edge groove extending substantially perpendicularly to the printing direction being disposed on the printing start side of the image area so as to be independent of the cells, and the image area having an outline groove having a constant width and defining at least a portion of the outline. The patent to Levy teaches fluid metering roll comprising at least one start edge groove 26 extending substantially perpendicularly to the printing direction being disposed on the printing start side of the image area so as to be independent of the cells, and the image area having an outline groove 28 having a constant width and defining at least a portion of the outline. It would have been obvious to those skilled in the art to modify Shimizu to have the grooves taught by Levy, in order to keep the ink in the appropriate areas.

Claims 15-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Okuyama (US 2003/0111158) in view of Shimizu. Okuyama teaches a method of manufacturing a multiplayer-ceramic electronic component comprising a conductive print paste used to define an internal electrode, and a ceramic green sheet (Abs.). Okuyama does not teach the press

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according to claim 1. Shimizu teaches the press according to claim 1 as described in the above rejection. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Okuyama to have the gravure cell structure as taught by Shimizu, in order to allow the paste to flow between cells thereby providing for a uniform printed image.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ren L. Yan whose telephone number is 571-272-2173. The examiner can normally be reached on 8:30am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Hirshfeld can be reached on 571-272-2168. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Ren L Yan
Primary Examiner
Art Unit 2854

Ren Yan
March 9, 2005